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Via Hand Delivery

May 18, 2009

James Toupin
Office of the General Counsel
United States Patent and Trademark Office
Madison East 10B20
600 Dulaney Street
Alexandria, VA 22314

OFFICE OF THE
GENERAL COUNSEL
2009 MAY 18 PM 5:05
U.S. PATENT
AND
TRADEMARK OFFICE

Re: Notice of Appeal

Dear Mr. Toupin:

Please find attached a Notice of Appeal, along with a copy of the Decision – Interlocutory Motions – Bd. R. 125(b) dated March 18, 2009, and Judgment – Merits – Bd. R. 127, dated March 18, 2009, of the Board of Patent Appeals and Interferences.

If you should have any questions please do not hesitate to call me.

Sincerely,

Davis Wright Tremaine LLP

Richard A. Gibbs

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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GENERAL COUNSEL
2009 MAY 13 PM 5:07
U.S. PATENT
AND
TRADEMARK OFFICE

Eliyahou Harari and Sanjay Mehrotra,

Appellants,

v.

NOTICE OF APPEAL

Shane C. Hollmer and Lee E. Cleveland,

Appellees.

Eliyahou Harari and Sanjay Mehrotra hereby appeal the court for review of the Decision -
- Interlocutory Motions -- Bd.R. 125(b), Judgment – Merits – Bd.R. 127, and Orders therein of
the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office
entered on March 18, 2009. The Decision, Judgment and Orders were received on March 18,
2009.



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Of Attorneys for Appellants,
Eliyahou Harari and Sanjay Mehrotra

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ELIYAHOU **HARARI** and SANJAY MEHROTRA
Junior Party
(Application 09/310,880)¹

v.

SHANE C. **HOLLMER** and LEE E. CLEVELAND
Senior Party
(Patent 5,828,601)²

Patent Interference No. 105,606 (JL)
(Technology Center 2800)

Before: RICHARD E. SCHAFER, JAMESON LEE, and RICHARD TORCZON,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION -- INTERLOCUTORY MOTIONS -- Bd. R. 125(b)

1 Filed May 14, 1999. The real party in interest is SanDisk Corporation.

2 Based on Application 08/160,582, filed December 1, 1993. The real party in interest is Spansion LLC.

1 Each party has filed a single substantive motion. Harari's motion seeks to
2 have Harari accorded the benefit of applications 07/337,566, 07/963,838,
3 08/174,768, and 08/771,708. Hollmer's motion asserts unpatentability of all of
4 Harari's claims 76-80 corresponding to the count, for lack of written description
5 under 35 U.S.C. § 112, first paragraph. Oral argument was held on December 17,
6 2008. We grant Hollmer's motion and dismiss Harari's motion.

7 **A. Hollmer's Substantive Motion 1**

8 By this motion Hollmer alleges unpatentability of Harari's claims 76-80
9 under 35 U.S.C. § 112, first paragraph, as lacking written description in the
10 specification.

11 **Findings of Fact**

12 1. This interference was declared on January 28, 2008. (Paper 1).

13 2. Harari is involved in this interference on the basis of Application
14 09/310,880 (Harari's involved '880 application), filed May 14, 1999. (Paper 1).

15 3. The only pending claim in Harari's involved application are claims
16 76-80, and all of them have been designated at the time of declaration of this
17 interference as corresponding to the sole count in this interference. (Paper 1).

18 4. Harari's involved '880 application is titled "FLASH EEprom
19 SYSTEM." (Exhibit 1002).

20 5. Harari's involved '880 application, as filed on May 14, 1999, had
21 original claims 1-62 and original Figures 1-8. (Exhibit 1002).

22 6. "EEprom" is a term of art meaning semiconductor electrically
23 erasable programmable read only memories. (Exhibit 1002, 1:5-7).

24 7. A preliminary amendment was filed on the same day Harari's
25 involved '880 application was filed, May 14, 1999. (Exhibit 1003).

1 8. The declaration filed with Harari's involved '880 application makes
2 no reference to any preliminary amendment accompanying the application.

3 9. The preliminary amendment cancelled all original claims 1-62, and
4 added new claims 63-75. (Exhibit 1003).

5 10. The preliminary amendment added new Figures 9-27. (Exhibit 1003).

6 11. The preliminary amendment also added approximately 22 pages of
7 technical disclosure to the specification as filed, and 17 sheets of new drawings
8 containing new Figures 9-27. (Exhibit 1003).

9 12. The preliminary amendment added a section to the disclosure of the
10 invention, which indicated that the involved application is a continuation of
11 Application 08/771,708 ('708 application), filed December 20, 1996, which is a
12 continuation of Application 08/174,768 ('768 application), filed
13 December 29, 1993, which is a continuation of Application 07/963,838
14 ('838 application), filed October 20, 1992, which is a division of Application
15 07/337,566 ('566 application), filed April 13, 1989. (Exhibit 1003, 1:8-12).

16 13. The remarks portion of the preliminary amendment (Exhibit 1003) on
17 page 25 contains the following explanation of the source of the additional material
18 inserted into the application (emphasis added):

19 The present application, at page 11, lines 27-31, incorporates by
20 reference another application entitled "Multi-State EEprom Read and
21 Write Circuits and Techniques", **filed on the same day as the initial**
22 **parent to the present application, namely April 13, 1989**, by
23 Sanjay Mehrotra and Eliyahou Harari, two of the inventors who are
24 also named in the present application. This incorporated application is
25 Serial No. 07/337,579, now abandoned, continuations-in-part of
26 which have issued as patents nos. 5,163,021 and 5,172,338. The

1 present amendment inserts a majority of the incorporated Serial No.
2 07/337,579 into the present application.

3
4 Therefore, essentially all of the Summary of the Invention,
5 Brief Description of the Drawings and Description of the Preferred
6 Embodiments sections of Serial No. 07/337,579 are being added to the
7 present application. . . .

8
9 14. At the designated location in Harari's specification as originally filed,
10 i.e., Exhibit 1002, page 11, lines 25-31, the incorporation by reference language
11 does not refer to an application filed on the same day as the "**the initial parent to**
12 **the present application**," as Harari's preliminary amendment states, but instead
13 refers to an application which is "copending" and filed on the same day as "**the**
14 **present application**."

15 15. In the context of Harari's involved '880 application, the words "the
16 present application" identifies no application other than Harari's involved '880
17 application, and that application was filed on May 14, 1999.

18 16. The original disclosure of Harari's present application, as filed on
19 May 14, 1999, and attested to by an accompanying declaration of the inventors
20 Sanjay Mehrotra and Eliyahou Harari, contains no incorporation by reference
21 language expressly referring to (1) "the initial parent to the present application,"
22 (2) an application filed on April 13, 1989, or (3) Application 07/337,579.

23 17. The material Harari added by preliminary amendment to the
24 disclosure of its involved application as filed on May 14, 1999, comes from
25 Application 07/337,579 ("the source '579 application").

1 18. The source '579 application is titled "MULTI-STATE EEPROM
2 READ AND WRITE CIRCUITS AND TECHNIQUES," names two co-inventors
3 Sanjay Mehrotra and Eliyahou Harari, and was filed on April 13, 1989.

4 19. Harari expressly abandoned the source '579 application by a
5 communication dated September 12, 1990 (Exhibit 2012A), and a Notice of
6 Abandonment was issued by the Examiner on November 7, 1990. (Exhibit
7 2012B).

8 20. A transmittal sheet (Exhibit 1001) accompanied Harari's involved
9 '880 application when filed, which requests the filing of a continuation application
10 of the '708 application, stating that the enclosed application is a copy of the '708
11 application, and stating that the enclosed declaration is a copy of the declaration
12 previously filed. (Exhibit 1001, ¶¶ 1-2).

13 21. The '708 application was filed on December 20, 1996. A transmittal
14 sheet accompanied the '708 application when filed, which requests the filing of a
15 continuation of the '768 application, stating that the enclosed application is a copy
16 of the '566 application filed on April 13, 1989, and stating that the enclosed
17 declaration is a copy of the declaration previously filed in the '566 application.
18 (Exhibit 2007, p.1).

19 22. The '768 application was filed on December 29, 1993. A transmittal
20 sheet accompanied the '768 application when filed, which requests the filing of a
21 continuation application of the '838 application, stating that the enclosed
22 application is a copy of the '838 application, and stating that the enclosed
23 declaration is a copy of the declaration previously filed in the '838 application.
24 (Exhibit 2005, p. 1).

1 23. The '838 application was filed on October 20, 1992. A transmittal
2 sheet accompanied the '838 application when filed, which requests the filing of a
3 divisional application of the '566 application, stating that the enclosed application
4 is a copy of the '566 application, and stating that the enclosed declaration is a copy
5 of the declaration previously filed in the '566 application. (Exhibit 2003, p. 1).

6 24. The '566 application was filed on April 13, 1989, the same date the
7 source '579 application was filed.

8 25. The '566 application is the only application in the chain of
9 applications of Harari, starting from the '566 application, to the '838 application,
10 to the '768 application, to the '708 application, to Harari's involved '880
11 application, that is filed on the same date as the source '579 application.

12 26. A Notice of Abandonment issued in the '566 application on
13 March 18, 1993, on the ground of failure to respond to an Office action.

14 27. As is stated in the Background of the Invention portion of Harari's
15 involved '880 application as filed, Harari's invention is directed to "a system of
16 integrated circuit Flash EEPROM chips." (Exhibit 1002 1:5-8).

17 28. Harari's involved '880 application contains two incorporation by
18 reference statements, the first is located in the disclosure from page 11, line 23,
19 through page 12, line 5, and reads as follows:

20 Optimized erase implementations have been disclosed in two
21 copending U.S. patent applications. They are copending U.S. patent
22 applications, Serial No. 204,175, filed June 8, 1988, by Dr. Eliyahou
23 Harari and one entitled "Multi-State EEPROM Read and Write Circuits
24 and Techniques," filed on the same day as the present application, by
25 Sanjay Mehrotra and Dr. Eliyahou Harari. The disclosures of the two
26 applications are hereby incorporated by reference. The Flash EEPROM

1 cells are erased by applying a pulse of erasing voltage followed by a
2 read to verify if the cells are erased to the "erased" state. If not,
3 further pulsing and verifying are repeated until the cells are verified to
4 be erased. By erasing in this controlled manner, the cells are not
5 subject to over-erasure which tends to age the EEprom device
6 prematurely as well as make the cells harder to program.
7

8 29. In the preliminary amendment, Harari deleted the language "filed on
9 the same day as the present application," and inserted, instead, "Serial No.
10 07/337,579, filed April 13, 1989, now abandoned..." (Exhibit 1003, 5:16-18).

11 30. The second incorporation by reference statement in Harari's involved
12 '880 application, is located in the disclosure from page 22, line 11, through line 23,
13 and refers back to the two copending applications cited in the first incorporation by
14 reference statement:

15 Optimized implementations of write operation for Flash EEprom
16 device have been disclosed in two previously cited co-pending U.S.
17 patent applications, Serial No. 204,175, and one entitled "Multi-State
18 EEprom Read and Write Circuits and Techniques." Relevant portions
19 of the disclosures are hereby incorporated by reference. Briefly,
20 during the write cycle, the controller applies a pulse of programming
21 (or writing) voltages. This is followed by a verify read to determine if
22 all the bits have been programmed properly. If the bits did not verify,
23 the controller repeats the program/verify cycle until all bits are
24 correctly programmed.
25

26 31. In the preliminary amendment, Harari inserted the language "Serial
27 No. 07/337,579, filed April 13, 1989, now abandoned" to more particularly
28 identify the second one of the two applications referred to in the incorporation by
29 reference language. (Exhibit 1003, pp. 5:20-21).

1 32. The source '579 application states in its Background of the Invention
2 section that the “invention relates generally to semiconductor electrically erasable
3 programmable read only memories (EEPROM), and specifically to circuits and
4 techniques for reading and programming their state.” (Exhibit 2011, p. 1:5-9).

5 33. The source '579 application is organized into the below-identified
6 sections (Exhibit 2011):

7 Background of the Invention

8 Summary of the Invention

9 Brief Description of the Drawings

10 Description of the Preferred Embodiments

11 “Split-Channel” EEPROM Cell

12 Addressable Flash EEPROM Array

13 Flash EEPROM System

14 Read Circuits and Techniques Using Reference Cells

15 On Chip Program Verify

16 Variable Control of Voltage to the Control Gate

17 Claims

18 Abstract

19 Drawings

20 Patent Application Declaration

21 34. The disclosure of the source '579 application does not contain a
22 separate section on erasing or writing the memory nor does it contain a section on
23 reading the memory. (Exhibit 2011).

1 *Acell, Inc.*, 460 F.3d 1365, 1376 (Fed. Cir. 2006); *Advanced Display Sys., Inc. v.*
2 *Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). “Whether and to what
3 extent material has been incorporated by reference into a host document is a
4 question of law.” *Cook Biotech Inc.*, 460 F.3d at 1376. (citation omitted).

5 “[P]atent draftsmanship is an exacting art, and no less care is required in
6 drafting an incorporation by reference statement than in any other aspect of a
7 patent application.” *Zenon Environmental Inc.*, 506 F.3d at 1382 n.3.

8 A mere claim of priority of the filing date of an earlier application does not
9 constitute an incorporation by reference of the content of the earlier application. *In*
10 *re De Seversky*, 474 F.2d 671, 674 (CCPA 1973)(“[T]he statement that an
11 application is a continuation-in-part, or a continuation, or a division, or in part a
12 continuation of another application is in a broad sense a ‘reference’ to the earlier
13 application, but a mere reference to another application, or patent, or publication is
14 not an incorporation of anything therein into the application containing such
15 reference for the purpose of the disclosure required by 35 U.S.C. § 112.”); *In re*
16 *Lund*, 376 F.2d 982, 989 (CCPA 1967)(The mere recitation that an application is a
17 “continuation-in-part” does not incorporate the entire disclosure of the parent
18 application into the CIP).

19 Analysis

20 Hollmer as the moving party bears the burden of proof to demonstrate
21 entitlement to the relief requested. 37 C.F.R. § 41.121(b).

22 By this motion Hollmer alleges that all of Harari’s claims 76-80
23 corresponding to the count are unpatentable under 35 U.S.C. § 112, first paragraph,
24 for lack of written description in the specification of Harari’s involved ‘880

1 application as filed on May 14, 1999. That specification does not include the 22
2 pages of new text and 17 sheets of new drawings added by preliminary amendment
3 filed on the same date, because the declaration filed with Harari's involved '880
4 application makes no reference to the preliminary amendment. Had the declaration
5 referred to the preliminary amendment, then the material added by the amendment
6 would have been regarded as a part of the original disclosure of the specification.
7 In pertinent part, Section 601.01(a) of the Manual of Patent Examining Procedure,
8 Seventh Edition (July 1998) states (600-9, column 1:39-44):

9 If an amendment is filed on the same day that the application filed
10 under 37 CFR 1.53(b) is filed and is referred to in the original oath or
11 declaration filed with or after the application, it constitutes a part of
12 the original application papers and the question of new matter is not
13 considered.
14

15 The addition of new matter by amendment into the disclosure is prohibited by
16 35 U.S.C. § 132. In the context of the written description requirement of 35 U.S.C.
17 § 112, first paragraph, at issue is the original disclosure of the specification.

18 Hollmer accepts that if the 22 pages of text and 17 sheets of drawings Harari
19 added by preliminary amendment had been properly "incorporated by reference" in
20 the specification as filed on May 14, 1999, then the material is not new matter
21 prohibited by 35 U.S.C. § 132, and Harari's claims 76-80 would have written
22 description in the specification as filed. (Paper 21). Harari accepts that if its
23 specification as filed did not properly incorporate by reference the 22 pages of text
24 and 17 sheets of drawings added by preliminary amendment, then its claims 76-80
25 would lack written description in the original disclosure and thus be unpatentable
26 under 35 U.S.C. § 112, first paragraph. (Paper 21).

1 matter is referred to in the incorporation by reference language, we decline to
2 consider that declaration because Hollmer's initial motion fails to set forth at least
3 a prima facie case that the incorporation by reference language contained in
4 Harari's involved '880 application specifically refers to only material for erasing
5 and writing into memory cells and not to material concerning the reading of
6 memory cells. On this issue because Hollmer bears the burden of proof it is not
7 necessary to consider Harari's opposition and Hollmer's reply.

8 With regard to the substantive matter incorporated by reference, Harari's
9 involved '880 application, on page 11, states:

10 Optimized erase implementations have been disclosed in two
11 copending U.S. patent applications. . . . The disclosures of the two
12 applications are hereby incorporate[d] by reference. The Flash
13 EEprom cells are erased by applying a pulse of erasing voltage
14 followed by a read to verify if the cells are erased to the "erased"
15 state. If not, further pulsing and verifying are repeated until the cells
16 are verified to be erased. By erasing in this controlled manner, the
17 cells are not subject to over-erasure which tends to age the EEprom
18 device prematurely as well as make the cells harder to program.

19
20 Also with regard to the substantive matter incorporated by reference,
21 Harari's involved '880 application, on page 22, states:

22 Optimized implementations of write operation for Flash EEprom
23 device have been disclosed in two previously cited co-pending
24 applications Relevant portions of the disclosures are hereby
25 incorporated by reference. Briefly, during the write cycle, the
26 controller applies a pulse of programming (or writing) voltages. This
27 is followed by a verified read to determine if all the bits have been
28 programmed properly. If the bits did not verify, the controller repeats
29 the program/verify cycle until all bits are correctly programmed.
30

1 The above-quoted text from Harari's involved '880 application indicates that
2 reading the memory is a part of both the operation to erase memory cells and the
3 operation to write into or program the memory cells, and that reading the memory
4 cells is key to the optimized erase and optimized write implementations referred to
5 in the incorporation by reference language.

6 The disclosure of the source '579 application is also not organized or
7 divided into neatly separated sections on reading, writing, and erasing of memory
8 cells. It includes the following labeled sections (Exhibit 2011):

9 Background of the Invention

10 Summary of the Invention

11 Brief Description of the Drawings

12 Description of the Preferred Embodiments

13 "Split-Channel" EEprom Cell

14 Addressable Flash EEprom Array

15 Flash EEprom System

16 Read Circuits and Techniques Using Reference Cells

17 On Chip Program Verify

18 Variable Control of Voltage to the Control Gate

19 Claims

20 Abstract

21 Drawings

22 Patent Application Declaration

23 Hollmer asserts that a person of ordinary skill in the art would readily
24 distinguish a memory's read operations which obtains or interprets data from the

1 memory cell from a memory's erase operation, and from a memory's write
2 operation which records information into a memory cell. (Hollmer Motion 1,
3 p. 10:7-10). Hollmer points to Harari's involved '880 application and states that it
4 distinguishes a read from a write and an erase. (Hollmer Motion 1, p. 10:11-16).
5 Hollmer also points to the source '579 application and states that it too
6 distinguishes a read from a write and an erase. (Hollmer Motion 1, p. 10:16-21).

7 Hollmer's assertions are misplaced. The question is not whether a read is
8 different from a write, or whether a read is different from an erase. Of course it is,
9 in both cases. Reading is not the same as writing or erasing. But to end the
10 discussion there as Hollmer has in its motion is overly simplistic. Hollmer's
11 motion does not acknowledge, much less address, the fact that the reading of
12 memory cells has been specifically described in Harari's '880 application as a key
13 part of the optimized erase implementation and the optimized write implementation
14 which have been incorporated by reference. Based on the above-quoted
15 description of the optimized erase and optimized write implementations which
16 have been identified for incorporation, one cannot perform the optimized erase or
17 the optimized write operation without some form of repeatedly reading the memory
18 cells being erased or written.

19 The failure of Hollmer's initial motion to address the full description of the
20 material being incorporated by reference, in particular the reliance of the optimized
21 erase and write operations on the memory read operation, undermines the
22 persuasiveness of Hollmer's assertions. Hollmer's initial motion fails to set forth a
23 prima facie case that the text and drawings added by Harari's preliminary

1 amendment are beyond the substantive scope of the material identified in Harari's
2 involved '880 application for incorporation by reference.

3 Even if we were to consider the declaration of Vivek Subramanian
4 (Exhibit 1015), which was submitted with Hollmer's reply, the outcome is no
5 different. Mr. Subramanian specifically acknowledges in ¶ 29 and ¶ 31 of his
6 declaration (Exhibit 1015) that the source '579 application makes clear that similar
7 circuits could be used for both read and program/erase verify operations, citing
8 page 28, lines 28-31 of the source '579 application, which states:

9 The read circuits and operation described are also employed in the
10 programming and erasing of the memory cells, particularly in the
11 verifying part of the operation.
12

13 The above-quoted text appears in the section of the source '579 application which
14 is labeled "Read Circuits and Techniques Using Reference Cells." While it is true
15 that the command line does actual reading to provide data as an output of the
16 memory chip, and the output lines to provide the data as an output of the memory
17 chip are not necessary for erase verify and write verify operations, Harari's claims
18 76-80 do not claim those basic features and thus whether the read command line
19 and the data output lines have been incorporated by reference is irrelevant.

20 If Hollmer's reply and Harari's opposition are both considered on the
21 specific issue of what substantive technical matter is referred to for incorporation,
22 assuming that the source '579 application has been clearly identified, we credit the
23 testimony of Harari's technical witness John A. Reed over the testimony of
24 Hollmer's witness Vivek Subramanian. Mr. Reed persuasively points out that the
25 reference in the incorporation by reference language to repeated reading the

1 memory cells would lead one with ordinary skill to the section in the source ‘579
2 application titled “Read Circuits and Techniques Using Reference Cells.”
3 (Exhibit 2021, ¶ 22:5-7). Mr. Reed further notes that the first two sentences of that
4 section reads as follows (Exhibit 2021, ¶ 22:7-10):

5 To accurately and reliably determine the memory state of a cell is
6 essential for EEprom operation. This is because all of the basic
7 functions such as read, erase verify and program verify depend on it.

8
9 Mr. Reed still further identifies the last three paragraphs of the section “Read
10 Circuits and Techniques Using Reference Cells” as discussing utilizing the read
11 circuits to verify whether the desired erased state has been achieved. (Exhibit
12 2021, ¶ 22:12-16). Note in particular that the third to the last paragraph in the
13 section begins with the sentence (Exhibit 2011, 28:28-31): “The read circuits and
14 operation described are also employed in the programming and erasing of the
15 memory cells, particularly in the verifying part of the operation.” The testimony
16 amply support Harari’s position, assuming that the ‘source ‘579 application has
17 been clearly identified, that the section titled “Read Circuits and Techniques Using
18 Reference Cells” is within the referenced material to be incorporated. Hollmer still
19 has not met its burden of proof on this issue.

20 **B.**

21 **The source ‘579 application is not an application identified**
22 **in Harari’s disclosure as having material for incorporation**
23

24 In this section we address whether the original written description of
25 Harari’s involved ‘880 application adequately identifies the source ‘579

1 application as a target document containing material that is incorporated by
2 reference.

3 The applicable standard for determining proper incorporation by reference is
4 whether the host document “identifies with detailed particularity” what specific
5 material it incorporates and “clearly indicate[s]” where that material is found in the
6 various documents.” *Zenon Environmental Inc.*, 506 F.3d at 1378; *Cook Biotech*
7 *Inc.*, 460 F.3d at 1376; *Advanced Display Sys., Inc.*, 212 F.3d at 1282. Under that
8 standard, it cannot be reasonably disputed that the document whose content is
9 being incorporated by reference must be clearly identified. If the targeted
10 document has not been clearly identified, it undermines and renders ineffective the
11 effort to determine what specific material within the targeted document has been
12 identified for incorporation by reference.

13 Hollmer points to the incorporation by reference language on pages 11 and
14 22 of the specification of Harari’s ‘880 application as filed and notes that aside
15 from Application Serial No. 204,175, Harari incorporates by reference the relevant
16 disclosures of an application which is (1) “copending,” (2) filed on the same day as
17 “the present application,” (3) entitled “Multi-State EEprom Read and Write
18 Circuits and Techniques,” and (4) filed by inventors Sanjay Mehrotra and Eliyahou
19 Harari.

20 Hollmer acknowledges that the source ‘579 application has the same title as
21 that referenced in the incorporation by reference language and is filed by the same
22 two inventors as those named in the incorporation by reference language. But
23 Hollmer correctly points out (1) that source ‘579 application is not copending with
24 Harari’s involved ‘880 application because the source ‘579 application was

1 abandoned no later than the date of the Notice of Abandonment issued on
2 November 7, 1990, and (2) that the source '579 application was not filed on the
3 same day as Harari's involved '880 application because the source '579 application
4 was filed on April 13, 1989, and Harari's involved '880 application was filed on
5 May 14, 1999.

6 By incorrectly noting that the incorporation by reference language refers to
7 an application "copending" with "the present application," and filed on the same
8 day as "the present application," Harari's involved application fails to identify with
9 detailed particularity the material to be incorporated. Hollmer's motion has made
10 out a prima facie case that the source '579 application which was abandoned prior
11 to the filing of Harari's involved '880 application on May 14, 1999, is not an
12 application any material of which has been incorporated by reference. We now
13 discuss Harari's opposition.

14 Harari's opposition arguments are difficult to understand. According to
15 Harari, the incorporation by reference language in Harari's involved '880
16 application "clearly and unambiguously" identifies the source '579 application for
17 incorporation by reference (Harari Opp. 1, p. 3:6-9). However, Harari does not
18 dispute that the source '579 application was neither copending with nor filed on the
19 same day as Harari's involved '880 application as is required by the instruction
20 used by Harari in the original disclosure of Harari's involved '880 application for
21 incorporation by reference. Harari also does not contend that it had been its own
22 lexicographer in coining a new meaning for the term "the present application" that
23 is different from its ordinary and conventional meaning that simply identifies the
24 application in which those words appear and are presented.

1 Given the discrepancy in the copending status and the date of filing of the
2 source '579 application with respect to that of "the present application," the
3 opposite of Harari's assertion is true, i.e., the incorporation by reference language
4 clearly and unambiguously did not identify the source '579 application as one
5 whose content is incorporated by reference into Harari's involved '880 application.

6 Harari's argument relies on events spanning over ten years and across five
7 generations of ancestral applications to override and replace the clear and
8 unambiguous specific identification made in the original disclosure of Harari's
9 involved '880 application. Harari's reasoning, even if assumed to be correct, is
10 tantamount to asking one to put on the hat of an investigator to ascertain what
11 Harari actually intended and desired to incorporate by reference notwithstanding
12 contrary language used by Harari in Harari's involved '880 application for
13 incorporation by reference. Furthermore, as will also be explained below, even the
14 reasoning in support of the results of the investigation is misplaced and incorrect.

15 Harari's analysis begins not from Harari's involved '880 application where
16 the incorporation by reference language for the involved '880 application resides,
17 but from as far away from Harari's involved '880 application as possible, in the
18 '566 application which was filed more than ten years prior to the filing of Harari's
19 involved '880 application. That is troublesome because at issue is the
20 incorporation by reference language of Harari's involved '880 application.
21 Harari's position would require the language of its involved '880 application to be
22 ignored and superseded by what it demonstrates it either intended to say or should
23 have said based on the prosecution history spanning over ten years, starting with
24 the '566 application, then the '838 application, then the '768 application, then the

1 '708 application, and then Harari's involved '880 application. However, the
2 standard for determining proper incorporation by reference is based on what the
3 incorporating language clearly states, not what one may figure out in a separate
4 investigation the applicants should have stated or meant to say.

5 Harari indicates that the same incorporation by reference language existed in
6 the disclosure of the '566 application which was filed on April 13, 1989, the same
7 day the source '579 application was filed. Thus, there was no discrepancy in the
8 context of the '566 application with regard to the copendency status and the date of
9 filing of the source '579 application. Material from the source '579 application
10 was incorporated by reference into the disclosure of the '566 application, which is
11 the grand-grand-grand-parent-application of Harari's involved '880 application.

12 On October 20, 1992, Harari filed the '838 application as a divisional
13 application of the '566 application, with a copy of the '566 application. Harari
14 contends that because the original disclosure of the '838 application was a copy of
15 the disclosure of the '566 application, and because the '838 application was a
16 divisional application of the '566 application, whatever was incorporated by
17 reference in the '566 application necessarily and automatically was carried through
18 and brought over into the '838 application.

19 On December 29, 1993, Harari filed the '768 application as a continuation
20 application of the '838 application, with a copy of the '838 application. Harari
21 contends that because the original disclosure of the '768 application was a copy of
22 the disclosure of the '838 application, and because the '768 application was a
23 continuation application of the '838 application, whatever was carried through

1 from the '566 application to the '838 application necessarily and automatically was
2 carried through and brought over into the '768 application.

3 On December 20, 1996, Harari filed the '708 application as a continuation
4 application of the '768 application, with a copy of the '566 application, which
5 would also be a copy of the '768 application. Harari contends that because the
6 original disclosure of the '708 application is a copy of the '768 application, and
7 because the '708 application was a continuation of the '768 application, whatever
8 was carried through from the '566 application to the '768 application necessarily
9 and automatically was carried through and brought over into the '708 application.

10 On May 14, 1999, Harari filed the involved '880 application as a
11 continuation application of the '708 application, with a copy of the '708
12 application. Harari contends that because the original disclosure of the involved
13 '880 application is a copy of the '708 application, and because the involved '880
14 application is a continuation of the '708 application, whatever was carried through
15 from the '566 application to the '708 application necessarily and automatically was
16 carried through and brought over into Harari's involved '880 application.

17 It is Harari's position that because the '566 application properly
18 incorporated by reference material from the source '579 application, and because
19 each progeny application stemming from the '566 application was filed with a
20 copy of the immediate parent application and identified as either a continuation or
21 divisional application, the material initially incorporated by reference into the '566
22 application silently worked its way all the way down the lineage into the '880
23 application. We reject Harari's argument, for several reasons.

1 Harari assumes that any application whose disclosure is a photocopy of
2 another application necessarily has identical disclosure as the other application.
3 That is an incorrect assumption. It is certainly incorrect when the applicants
4 embed context sensitive or context specific instructions in the first disclosure. In
5 this case, that context sensitive instruction is the reference to copending status and
6 the referenced application's being filed on the same day as "the present
7 application." Each time a subsequent application is filed, it has its own filing date
8 and "the present application" refers to the current application and not a previous
9 application. The situation is not unlike embedding a "macro" instruction in a
10 document produced by a word processor, which "macro" instruction instructs the
11 computer to insert the current date when the document is accessed and read or
12 printed. If the document is printed out on different dates, then each print out will
13 have different content. Similarly, if a dessert recipe includes instructions to use
14 fruit that is in season, then the actual content of the dessert will vary depending on
15 when the dessert is made, even though the words of the recipe will remain the
16 same.

17 Harari also assumes that if an application refers to itself as a continuation
18 application or divisional application of another application, then the two
19 applications necessarily have the same disclosure. That is incorrect. A mere claim
20 of priority of the filing date of an earlier application does not constitute an
21 incorporation by reference of the content of the earlier application. *In re De*
22 *Seversky*, 474 F.2d at 674; *see also In re Lund*, 376 F.2d at 989. Whether the two
23 applications have the same disclosure still has to be determined on a case by case
24 basis when an issue arises which requires such determination. Note that although

1 Harari's involved '880 application is a continuation of the '708 application, which
2 is a continuation of the '768 application, which is a continuation of the '838
3 application, which is a divisional of the '566 application, when this interference
4 was declared Harari was not accorded benefit of the filing dates of any one of the
5 four ancestral applications. Rather, Harari had to file a substantive motion to
6 establish entitlement to benefit, and that motion is Harari's Substantive Motion 1.

7 Moreover, the requirement for an application to be a continuation
8 application of a parent application is not that the two disclosures are the same, but
9 only that the continuation application does not contain material that is not in the
10 parent application. See Manual of Patent Examining Procedure, Section 201.07
11 (7th Edition) (July 1998). That means a continuation application does not
12 have to include all of the disclosure of the parent application. Therefore, even if
13 the '566 application properly identified the source '579 application and
14 incorporated by reference the disclosure of the source '579 application, it does not
15 mean any continuation application of the '566 application necessarily includes that
16 material. Similarly, a divisional application does not have to disclose everything
17 that is disclosed in the parent application. See Manual of Patent Examining
18 Procedure, Section 201.06 (7th Edition)(July 1998).

19 Harari asserts that the procedures of the U.S. Patent and Trademark Office
20 allows applicants to file a continuation application by filing a copy of the parent
21 application. The assertion is true but does not help Harari's position in opposing
22 Hollmer's motion. Harari has pointed to no rule of the U.S. Patent and Trademark
23 Office, or any part of the Manual of Patent Examining Procedure, which indicates
24 that a continuation or divisional application which is a photocopy of the parent

1 application necessarily has the same disclosure as the parent application, even
2 when the application includes incorporation by reference language the meaning of
3 which varies with time. Harari should have known that if it uses incorporating
4 language whose meaning varies with time, then filing the application at a different
5 time will result in a different disclosure.

6 Under different facts, Harari's argument may make sense. Had Harari
7 actually amended the '566 application to physically include the text and drawings
8 incorporated by reference from the source '579 application and then filed a copy of
9 the amended '566 application as each subsequent continuation or divisional
10 application, the incorporated material would have been carried forward into each
11 subsequent application. But such are not the facts of this case. Harari never
12 amended the '566 application to insert therein the actual text and drawings of the
13 material incorporated by reference from the source '579 application, and none of
14 the '566 application, the '838 application, the '768 application, the '708
15 application, and Harari's involved '880 application has an original disclosure as
16 filed which physically includes the actual text and drawings from the source '579
17 application.

18 Given the facts of this case, saying that the text and drawings from the source '579
19 application were first incorporated into the disclosure of the '566 application and
20 then carried through to each subsequent continuation or divisional application is
21 inconsistent with the record. Harari is urging that something that could have been
22 done but was not done equates to the same thing's having actually been done.

23 In any event, Harari's argument completely ignores the incorporation by
24 reference language that appears in the specification of Harari's involved '880

1 application as filed. The applicable standard for determining proper incorporation
2 by reference is whether the host document “identifies with detailed particularity”
3 what specific material it incorporates and “clearly indicate” where that material is
4 found in the various documents.” *Cook Biotech Inc.*, 460 F.3d at 1376; *Advanced*
5 *Display Sys., Inc.*, 212 F.3d at 1282. It is not based on what one might figure out
6 the applicants should have said or meant to say based on a separate investigation
7 notwithstanding and despite clear incorporation by reference language to the
8 contrary in the specification.

9 We have not overlooked Harari’s preliminary amendment that was filed on
10 the same day Harari’s involved ‘880 application was filed. It mistakenly describes
11 the incorporation by reference language on page 11 as referring to an application
12 that was filed on the same day as “the initial parent to the present application,”
13 when the actual incorporation by reference language refers not to “the initial parent
14 to the present application” but to “the present application.” It also amends the
15 specification as filed to specifically identify the source ‘579 application as an
16 application whose disclosure is incorporated by reference. But such new efforts at
17 incorporation by reference are ineffective because the preliminary amendment is
18 not referenced in the declaration of the inventors in support of Harari’s involved
19 ‘880 application and thus does not constitute a part of the original disclosure.

20 Per 35 U.S.C. § 132, no amendment may introduce new matter into the disclosure.

21 Thus, Harari’s preliminary amendment cannot cure the deficiencies of the actual
22 incorporation by reference language used in the specification as filed.

23 Harari could have avoided the present circumstance in several different
24 ways. First, it could have chosen not to use incorporation by reference language

1 which has a temporal element which changes with time, which necessarily varies
2 each time a copy of the application is filed as a continuation or divisional
3 application. Or, having used incorporation by reference language which applies a
4 temporal element as an identifying factor, it could have taken care not to simply
5 file a photocopy of the original application as a continuation or divisional
6 application, to avoid misidentification. Finally, when it prepared the preliminary
7 amendment to insert the text and drawings from the source '579 application at the
8 same time the involved '880 application was filed, it could have executed an oath
9 or declaration which makes reference to the preliminary amendment. Harari did
10 none of the above. Incorporation by reference is a convenient tool, but the
11 convenience comes with an intrinsic risk of misidentifying the target document.

12 As the Court of Appeals for the Federal Circuit stated in *Zenon*
13 *Environmental Inc.*, 506 F.3d 1370, 1382 n.3: “[P]atent draftsmanship is an
14 exacting art, and no less care is required in drafting an incorporation by reference
15 statement than in any other aspect of a patent application.” If Harari leaves critical
16 written description in an external document which is brought into the specification
17 by a statement of incorporation by reference, Harari risks the consequences of an
18 incorrect identification in the statement of incorporation by reference. Harari’s
19 own lack of precision caused the identification problem it confronts.

20 Harari’s opposition is accompanied by the declaration of its technical
21 witness John A. Reed. (Exhibit 2021). On page 11 of the opposition, and citing
22 Material Facts 73 and 74 in the opposition, Harari argues that it is unreasonable
23 that a person of ordinary skill in the art would read the incorporating language as
24 pertaining to anything but the source '579 application. Material Facts 73 and 74 of

1 Harari's opposition cite for support paragraphs 10, 11, and 26 of John Reed's
2 declaration. The cited paragraphs of John Reed's declaration, however, do not
3 lend support to the assertion. There is no testimony of John Reed to the effect that
4 it would have been unreasonable for one with ordinary skill in the art to read and
5 understand the term "the present application" as referring to the application
6 containing those words.

7 Rather, the testimony of John Reed is that in his opinion, a person of
8 ordinary skill in the art would have considered (1) that the disclosure of the source
9 '579 application was incorporated by reference into the '566 application, (2) that
10 whatever was incorporated by reference into the '566 application was incorporated
11 into Harari's involved '880 application because the involved '880 application was
12 a continuation of a continuation of a continuation of a divisional of the '566
13 application and each application as filed was "identical" to the disclosure of the
14 '566 application, and (3) that Harari intended to incorporate by reference the
15 disclosure of the source '579 application. (Exhibit 2021, ¶¶ 10, 11, 25, 26).

16 For several reasons, we do not credit the testimony of John Reed with any
17 substantial or meaningful weight. First, as we have already explained, the
18 disclosure as filed in each of the '566 application, the '838 application, the '768
19 application, the '708 application, and Harari's involved '880 application, are not
20 "identical" in light of the time-varying nature of the incorporation by reference
21 language used. John Reed's testimony does not account for the time dependent
22 nature of the term "the present application." He also makes the erroneous
23 assumption either that continuation and divisional applications necessarily have the
24 same disclosure as the parent application or that a continuation or divisional

1 application necessarily contains all the disclosure contained in the parent
2 application. He also focuses on the subjective “intent” of Harari’s inventors, and
3 ignores what the incorporation by reference language in Harari’s involved ‘880
4 application actually and clearly states. And finally, the qualification of John Reed
5 as a technical witness in the field of Flash EEproms is not helpful in supporting his
6 testimony concerning non-substantive aspects of which particular application, by
7 filing date, has been identified by the reference to “the present application.” We do
8 not consider his testimony either helpful or persuasive.

9 The standard for determining proper incorporation by reference is whether
10 the incorporation by reference language in the application clearly identifies the
11 material being incorporated, not whether one can play the role of detective and
12 mount an investigation of the prosecution history spanning over ten years and
13 multiple ancestral applications to ascertain what the applicant must have meant and
14 desired to do notwithstanding and despite what the incorporation by reference
15 language clearly states. The law on incorporation by reference does not allow
16 reformation of clear language stated in the specification, to something else which is
17 clearly not specified in the original disclosure, based on a demonstration of what
18 the applicants or his counsel meant to say or should have said.

19 We are aware that in *In re Fouché*, 439 F.2d 1237, 1240 (CCPA 1971), the
20 Court of Customs and Patent Appeals concluded that where an applicant left blank
21 the serial number of an application whose “Example 1” was being incorporated by
22 reference, subsequent insertion of that serial number into the specification did not
23 constitute new matter. The facts of this case are distinct from those in *In re*
24 *Fouché, supra*. The insertion of an actual serial number in *In re Fouché* was not

1 inconsistent with anything stated in the incorporation by reference language, while
2 in this case the identification attributes to the source '579 application, both in
3 application status and filing date, are contrary to those specified in the
4 incorporation by reference language of Harari's involved '880 application.

5 The phrase "the present application" in the incorporation by reference
6 language of Harari's involved '880 application as filed cannot be rewritten to state,
7 instead, "the initial parent application of the present application" without violating
8 the prohibition against the addition of new matter to the original disclosure. The
9 situation is not unlike that when an applicant inserts the wrong set of experimental
10 data into the original disclosure. Assuming that the insertion is a mistake, the
11 correct set of data is still new matter not contained in the specification as filed and
12 the specification cannot be subsequently amended to include a different set of data
13 points.

14 Even if one embarked on an extensive investigation on what the applicant
15 should have said or meant to say, it is not clear why the investigation would
16 necessarily rule out other potential answers and firmly settle on the specific
17 conclusion proposed by Harari. For example, there might in fact be a copending
18 application filed on the same date as Harari's involved '880 application, but with a
19 different title, or with the same title but different inventors than the two identified.
20 While Harari itself knows how the discrepancy in identification of the target
21 document truly came about, a third party would not.

22 The misidentification could have been in the title, the named inventors, or
23 the filing date of the target document. Although in this proceeding Harari was
24 ordered to produce a list of its applications which have the same title as that

1 identified for the applications incorporated by reference and naming at least the
2 two inventors referenced in the incorporation by reference language, whenever
3 filed, without the Board's order a third party would not have that information. In
4 response to the Board's order Harari filed a list (Paper 25) which includes at least 3
5 U.S. patent applications, 1 international patent application, 1 European patent
6 application, and 4 Japanese patent applications. If the misidentification is based
7 on the title of the invention or the named inventors, rather than the referenced
8 filing date, even more applications may be in the pool of all applications which
9 Harari possibly meant to identify for incorporation by reference. Even if one limits
10 consideration to U.S. applications only, multiple candidates fit the identification.

11 It cannot be overemphasized that the adequacy of written description is
12 measured from the face of the application, and not from what one with ordinary
13 skill in the art might be able to figure out. *New Railhead Mfg. v. Vermeer Mfg.*
14 *Co.*, 298 F.3d 1290, 1295 (Fed. Cir. 2002). The original disclosure itself must
15 show that the inventors invented each feature that is included as a claim limitation.
16 *Id.* A more lenient standard on what constitutes a proper incorporation by
17 reference undermines the vigor of the written description requirement of 35 U.S.C.
18 § 112, first paragraph. The issue is completeness of the original disclosure as filed,
19 not whether an earlier filed application of the applicant describes the missing
20 material. *Ex parte Schwarze*, 151 USPQ 426, 428 (Bd. Pat. App. 1966).

21 Finally, Harari argues that its involved application is entitled to the filing
22 date of the '566 application with respect to the involved claims. The argument is
23 misplaced and irrelevant to Hollmer's Substantive Motion 1. Even assuming that
24 Harari is entitled to the earlier filing date of the '566 application, it does not mean

1 there is written description in Harari's involved '880 application as filed to support
2 Harari's claims 76-80 under 35 U.S.C. § 112, first paragraph. The former concerns
3 the disclosure of the '566 application, and other ancestral applications providing a
4 chain of continuity from the '566 application to Harari's involved '880 application,
5 while the latter concerns the disclosure of Harari's involved '880 application.

6 As we have discussed at length above, because of the temporal element
7 injected by Harari into the incorporation by reference language in each application,
8 the disclosures of the '566 application, the '838 application, the '768 application,
9 the '708 application, and Harari's involved '880 application are not the same. The
10 five applications are filed on different dates. The statement "filed on the same day
11 as the present application" appearing in the five applications respectively refers, in
12 each application, to a different date. The term "the present application" in Harari's
13 involved '880 application does not identify the '566 application filed on
14 April 13, 1989, ten years prior to the filing of the involved '880 application, and
15 abandoned by March 18, 1993, six years prior to the filing of the involved '880
16 application.

17 Based on the foregoing, we conclude that the original disclosure of Harari's
18 involved '880 application does not identify the source '579 application as a
19 document having content that is incorporated by reference into the disclosure of
20 Harari's involved '880 application. Consequently, the 22 pages of text and 17
21 sheets of drawings inserted by preliminary amendment and copied from the source
22 '570 application constitute new matter and cannot be relied upon to provide written
23 description under 35 U.S.C. § 112, first paragraph, for Harari's claims 76-80.

24

Conclusion

Hollmer has shown by a preponderance of the evidence that Harari's claims 76-80 are unpatentable under 35 U.S.C. § 112, first paragraph, as lacking written description in the original disclosure as filed on May 14, 199B. Harari's Substantive Motion 1

By this motion, Harari seeks to be accorded benefit of the earlier filing dates of the '708 application filed on December 20, 1996, the '768 application filed on December 29, 1993, the '838 application filed on October 20, 1992, and the '566 application filed on April 13, 1989.

Per 37 C.F.R. § 41.201, because Harari provoked this interference (Paper 17 in Application 09/310,880 received September 14, 2001), unpatentability of Harari's involved application claims under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification is a threshold issue. Because Hollmer's Substantive Motion 1 has been granted, Harari lacks standing to proceed further in this interference. It is not necessary to decide Harari's Substantive Motion 1.

ORDER

It is

ORDERED that Hollmer's Substantive Motion 1 is granted;

FURTHER ORDERED that Harari's Substantive Motion 1 is dismissed;

and

FURTHER ORDERED that judgment against Harari is issued in a separate and concurrent paper.

Interference 105,606
Harari v. Hollmer

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Paper 62
Filed: 18 March 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ELIYAHOU **HARARI** and SANJAY MEHROTRA
Junior Party
(Application 09/310,880)¹

v.

SHANE C. **HOLLMER** and LEE E. CLEVELAND
Senior Party
(Patent 5,828,601)²

Patent Interference No. 105,606
(Technology Center 2800)

Before: RICHARD E. SCHAFFER, JAMESON LEE, and RICHARD TORCZON,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

Judgment – Merits – Bd. R. 127

1 Filed May 14, 1999. The real party in interest is SanDisk Corporation.

2 Based on Application 08/160,582, filed December 1, 1993. The real party in interest is Spansion LLC.

Hollmer's Substantive Motion 1 alleging unpatentability of all of Harari's claims corresponding to the count under 35 U.S.C. § 112, first paragraph, as lacking written description in the specification has been granted in a separate and concurrent paper. Because Harari provoked this interference, the granting of Holler's Substantive Motion 1 means Harari is without standing to continue in this interference. 37 C.F.R. § 41.201. Accordingly, it is now time appropriate to enter judgment against Harari.

It is

ORDERED that judgment as to Count 1 is entered against junior party ELIYAHOU HARARI and SANJAY MEHROTRA;

FURTHER ORDERED that junior party ELIYAHOU HARARI and SANJAY MEHROTRA is not entitled to its application claims 76-80 which correspond to Count 1;

FURTHER ORDERED that application claims 76-80 of junior party ELIYAHOU HARARI and SANJAY MEHROTRA are finally refused;

FURTHER ORDERED that the parties should note the requirements of 35 U.S.C. §135(c) and Bd.R. 205; and

FURTHER ORDERED that a copy of this judgment shall be entered into the file of Application 09/310,880 and Patent 5,828,601.

Interference 105,606
Harari v. Hollmer

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CERTIFICATE OF SERVICE

I hereby certify that on the 18th day of May, 2009, the foregoing Notice of Appeal, along with a copy of the Decision – Interlocutory Motions – Bd. R. 125(b) dated March 18, 2009, and Judgment – Merits – Bd. R. 127, dated March 18, 2009, of the Board of Patent Appeals and Interferences was served by email and overnight courier addressed to the following:

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